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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,992	10/29/2003	Toshiaki Ouchi	065905-0300	5302

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FOLEY AND LARDNER
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WASHINGTON, DC 20007

EXAMINER

MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,992

Applicant(s)

OUCHI ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains various grammatical errors. For example, "ordinary sheet" in line 9, should be "the ordinary sheet" and "prevent generation of defective image caused by bending of sheet" should be -- prevent the generation of a defective image caused by the bending of the sheet -- in lines 11-12. Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities: (1) the specification contains grammatical errors and some nonsensical language. For example, page 1, lines 14-15 recite "...standard-size ordinary sheet of high using frequency..." Another example is on page 3, lines 19-22, which states, "The special sheet are inserted between the special sheet ribs and guided while other sheet than the special sheet are guided by a sheet guide by passing the upper surface of the special sheet ribs." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign

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document and are replete with grammatical and idiomatic errors. As one example, independent claim 1 recites a sheet guide provided between the manual sheet supply unit and the conveying member, having special sheet ribs to control both sides of the special sheet that is inserted and guided **the special sheet ribs and the sheet other than the special sheet is guided by passing the upper surface of the special sheet ribs**. It is unclear how the sheets are guided. At least claims 2, 4-7 and 9-10 also have grammatical and idiomatic errors.

Regarding claims 4 and 9, it is also unclear which side of the sheet is the back of the sheet.

Regarding claims 2 and 7, it is also unclear whether applicant is trying to claim the special sheet and the sheet other than the special sheet as part of the sheet feeder or only claim the elements of the sheet feeder set forth in independent claims 1 and 6.

4. Claims 5 and 10 contain the trademark/trade name Mylar. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe

the material of the pressing member and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Horiuchi et al. In particular, Horiuchi et al. meets all of the limitations set forth in claims 1-10.

Regarding independent claim 1, as best understood, Figs. 2-8 of Horiuchi et al. show a sheet feeder (including 13 and 15-18) in an image forming apparatus (1) comprising:

a manual sheet supply unit (16) to supply special sheet and sheet other than the special sheet;

a conveying member (13) to convey the special sheet and the sheet other than special sheet supplied from the manual sheet supply unit (16) toward an image forming process unit (e.g., 4); and

a sheet guide (27a) provided between the manual sheet supply unit (16) and the conveying member (13), having special sheet ribs (Fig. 5) to control both sides of the special sheet that is inserted and guided the special sheet ribs (Fig. 5) and the sheet other than the special sheet is guided by passing the upper surface (e.g., 31a) of the

special sheet ribs (Fig. 5). The ribs of Fig. 5 contact one side of each sheet conveyed past the ribs. By controlling the surface of the sheet in contact with the ribs, the whole sheet (i.e., both sides of the sheet) can be controlled.

Turning now to independent claim 6, Figs. 2-8 show a sheet feeder (including 13 and 15-18) in an image forming apparatus (1) comprising:

a manual sheet supply unit (16) to supply special sheet and sheet other than the special sheet on a manual sheet supply tray (18);

aligning rollers (13) to align the leading edges of the special sheet and the sheet other than the special sheet supplied from the manual sheet supply unit (16) and convey in the image forming direction (along path 14), and

a sheet guide (27a) provided between the manual sheet supply unit (16) and the aligning rollers (13), having special sheet ribs (Fig. 5) to control both sides of the special sheet that is inserted and guided between the special sheet ribs (Fig. 5) and the sheet other than the special sheet is guided by passing the upper surfaces (e.g., 31a) of the special sheet ribs (Fig. 5). As mentioned above with regard to claim 1, by controlling the surface of the sheet in contact with the ribs, the whole sheet (i.e., both sides of the sheet) can be controlled.

Regarding the dependent claims 2 and 7, as best understood, Horiuchi et al. discloses a mass of a special sheet is larger than a mass of a sheet other than the special sheet. For example, column 1, lines 37-49 disclose that it is well known to use different size sheets in sheet supply units, which will have different masses.

Regarding the dependent claims 3 and 8, as best understood, Fig. 2 shows that the manual sheet supply unit (16) supplies the special sheet and the sheet other than the special sheet in a horizontal direction, and the conveying member (one roller 13) or aligning rollers (both rollers 13) convey the special sheet and the sheet other than the special sheet in a vertical direction.

Regarding the dependent claims 4 and 9, as best understood, Fig. 7 shows that the sheet guide (27a) further has a pressing member (35) between the special sheet ribs supports back of the sheet other than the special sheet by pressing and descends when the special sheet is inserted between the ribs. See also column 8, line 47 to column 9, line 5.

Regarding the dependent claims 5 and 10, as best understood, Horiuchi et al. discloses that the pressing member (35) is made of a compressed or pressing Mylar™ that descent by an empty weight of the special sheet when the special sheet is inserted. In as much as the arrangement of the guide and the pressing member of Horiuchi et al. is substantially similar to the arrangement of the guide and the pressing member of the instant application, Horiuchi et al. meets the limitations of claims 5 and 10.

6. Claims 1, 3, 6, and 8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 7-76438. In particular, Japanese Publication No. 7-76438 meets all of the limitations set forth in claims 1, 3, 6 and 8.

Regarding independent claim 1, as best understood, Figs. 1-7 show a sheet feeder (including 2 and 10) in an image forming apparatus (1) comprising:

a manual sheet supply unit (11a) to supply special sheet and sheet other than the special sheet;

a conveying member (21) to convey the special sheet and the sheet other than special sheet supplied from the manual sheet supply unit (11a) toward an image forming process unit (e.g., an image recording part); and

a sheet guide (30) provided between the manual sheet supply unit (11a) and the conveying member (21), having special sheet ribs (Fig. 5) to control both sides of the special sheet that is inserted and guided the special sheet ribs (Fig. 5) and the sheet other than the special sheet is guided by passing the upper surface (e.g., 32) of the special sheet ribs (Fig. 5). The ribs of Fig. 5 contact one side of each sheet conveyed past the ribs. By controlling the surface of the sheet in contact with the ribs, the whole sheet (i.e., both sides of the sheet) can be controlled.

Turning now to independent claim 6, Figs. 1-7 show a sheet feeder (including 2 and 10) in an image forming apparatus (1) comprising:

a manual sheet supply unit (11a) to supply special sheet and sheet other than the special sheet on a manual sheet supply tray (11a);

aligning rollers (21) to align the leading edges of the special sheet and the sheet other than the special sheet supplied from the manual sheet supply unit (11a) and convey in the image forming direction (along path 20), and

a sheet guide (including 30) provided between the manual sheet supply unit (11a) and the aligning rollers (e.g., 22 and 23), having special sheet ribs (ribs on 30 in Fig. 5) to control both sides of the special sheet that is inserted and guided between the

special sheet ribs (ribs on 30 in Fig. 5) and the sheet other than the special sheet is guided by passing the upper surfaces (e.g., 32) of the special sheet ribs (ribs on 30 in Fig. 5). As mentioned above with regard to claim 1, by controlling the surface of the sheet in contact with the ribs, the whole sheet (i.e., both sides of the sheet) can be controlled.

Regarding the dependent claims 3 and 8, as best understood, Figs. 1 and 7 show that the manual sheet supply unit (11a) supplies the special sheet and the sheet other than the special sheet in a horizontal direction, and the conveying member (21) or aligning rollers (e.g., 22 and 23) convey the special sheet and the sheet other than the special sheet in a vertical direction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is 703-305-0554. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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